

REMARKS

I. Status of claims

Claims 37, 40-45, and 47-50 and 53 are pending in this application. By this Amendment, claims 37 and 44 have been amended and new claim 53 has been added. No new matter has been added by these amendments. The amendments to claim 44 are supported, for example, by the embodiment described on page 9, beginning on line 5, of the original specification. Support for new claim 53 can be found throughout the original specification.

II. Claim Rejections under 35.U.S.C. §103(a)

Claims 37, 40-45, and 47-50 have been rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,070,153 to Simpson in view of U.S. Patent No. 6,631,358 B1 to Ogilvie, in view of U.S. Patent No. 6,345,261 B1 to Feidelson et al. (hereinafter “Feidelson”) in view of “*The new cobrand wisdom: mine your backyard*” in Credit Card News (hereinafter “Credit Card News”) in further view of case law (*In re Venner*). This rejection is respectfully traversed.

Even if combined, Simpson, Ogilvie, Feidelson, Credit Card News and *In re Venner* fail to disclose the features of independent claims 37 and 44. In summary, the Office Action fails to establish a *prima facie* case of obviousness. Specifically, before considering what would be obvious to one of ordinary skill in the art at the time of the invention, the art must teach or suggest the claim limitations. See MPEP §2143.

Simpson discloses a system in which a card issuer offers an investment account to customers having credit accounts. Simpson provides applicants with two applications, one for a credit account and one for an investment account (See Fig. 1, steps 1, 2A, and 3). Multiple

funding arrangements for the investment account are offered in Simpson and these funding arrangements may be combined.

Even if combined, the references fail to disclose all of the features of independent claims 37 and 44. With respect to claim 37, which requires a computerized method for implementation of multiple accounts, the references fail to show multiple features. None of the references discloses a first set of features (I) including providing an investment fund card application to an applicant, the investment fund card application entitling an approved cardholder to establish a card payment instrument account and an investment account, approving a submitted investment fund card application, and establishing the card payment instrument account through the card issuer for the approved cardholder upon approval, wherein the card payment instrument account includes a reward feature available to the cardholder. The references further fail to show automatically creating the investment account for the approved cardholder through the financial institution upon approval of the investment fund card application.

Specifically, Simpson fails to disclose an investment fund card application. Simpson discloses two separate applications, one for an investment fund and another for a credit card. The Office Action alleges that Ogilvie discloses this feature. Ogilvie discloses an arrangement between a consumer and a credit card issuer that allows funds to be deposited on behalf of the consumer in a consumer-specified account. The portion of Ogilvie referenced by the Examiner (Column 1, lines 56-57) to show that only one application is used refers to a prior art arrangement in which a bank issuing a credit card also holds an account in which consumer funds can be deposited. Thus, since only one entity (the card issuer) is involved with the consumer in the system of Ogilvie, the one application is only with the card issuing entity and not with two entities as required by claim 37. Thus, the disclosure of Ogilvie does not include

providing an investment fund card application to an applicant, the investment fund card application entitling an approved cardholder to establish a card payment instrument account *with a card issuer* and an investment account *with a financial institution* as required by claim 37. The financial institution and the card issuer are claimed as differing entities such that a reward structure is established *through an agreement between the financial institution and the card issuer*. Thus, in order to provide a sufficient teaching, a reference would at least have to teach a single application for services through two different entities rather than through the same entities.

As noted in the Office Action, Simpson also fails to disclose a second set of features (II) including issuing a card payment instrument linked to the multiple accounts, the card payment instrument bearing the name of the financial institution and the name of the card issuer.

Ogilvie, Feidelson, Credit Card News, and case law fail to obviate the deficiencies of Simpson. Specifically, none of these references discloses feature set (II) above including a credit card bearing two names including the name of a financial institution and that of a credit card issuer as required by claim 37. The Office Action references Feidelson for this feature. However, Feidelson merely discloses that a card may be a co-branded credit card between an administrator and a credit card issuer. This disclosure in itself does not necessarily pertain to the physical features of the card such that the card bears the name of a financial institution and a credit card issuer as required by pending claim 37.

The Office Action further alleges that *In re Venner* renders automating a manual activity obvious and therefore, it would have been obvious to automatically create the investment account upon application approval for the applicant. However, the manual activity itself of submitting a single application for two different accounts managed by two different entities and establishing the accounts upon approval does not appear to be known as the Examiner has not

produced any art to disclose this feature. Finally, the supplemental references fail to disclose any information relevant to the features discussed above.

Thus, because the references, even if combined, fail to disclose the features of the invention of claim 37 and further because no motivation, teaching, or suggestion has been provided for arriving at the combination of features, the Office Action has failed to establish a *prima facie* case of obviousness. Likewise, dependent claims 40-43 depend from claim 37 and therefore define over the art of record for the reasons set forth above with respect to claim 37.

Independent claim 44 defines over Simpson and the supplemental references for similar reasons. Specifically, the combination of references fails to disclose simultaneously offering multiple accounts including the card payment instrument account through the card issuer and the investment account from the financial institution by providing an investment card application.

The references collectively further fail to disclose that when a recipient of an offer for multiple accounts accepts the offer for multiple accounts by completing the investment card application, the card payment instrument account is established in response to the acceptance. Specifically, in Simpson, multiple applications must be completed for multiple accounts.

The references further fail to disclose creating the investment account in response to the acceptance when the card issuer notifies the financial institution to create the investment account upon establishment of the card payment instrument account by the card issuer. Simpson fails to disclose that the card issuer notifies the financial institution to open an investment account upon approval and establishment of the card payment instrument account as required by claim 44. Instead, in Simpson, the investment account can only be opened when the cardholder completes an application.

The references additionally fail to disclose issuing a card payment instrument linked to the multiple accounts, the card payment instrument bearing the name of the financial institution and the name of the card issuer and establishing a reward structure through an agreement between the financial institution and the card issuer as explained above.

The supplemental references applied by the Examiner fail to obviate the deficiencies of Simpson noted above. Accordingly, for at least the reasons set forth above, the references fail to render obvious claim 44. Dependent claims 45 and 47-50, define further distinctive features of the invention and define over the art of record for at least the reasons set forth above with respect to claim 44. Applicants respectfully traverse and request withdrawal of this rejection under 35 U.S.C. §103 as it may be applied to the currently pending claims.

New claim 53 includes additional distinctive features and is allowable over the art of record. Prompt examination on the merits is respectfully requested.

III. Conclusion

As set forth above, applicant respectfully submits that all claims are in condition for allowance. Withdrawal of all rejections and prompt passage to issuance are earnestly requested. In the event Applicant has overlooked the need for an extension of time, payment of fee, or additional payment of fee, Applicant hereby petitions therefore and authorizes that any charges be made to Deposit Account No. 50-4494.

Should the Examiner have any questions regarding any of the above, the Examiner is respectfully requested to telephone the undersigned at 202-346-4016.

Respectfully submitted,

Dated: November 7, 2008

By: Electronic Signature: /Kerry H. Owens/
Kerry H. Owens
Reg. No. 37,412
Goodwin|Procter LLP
901 New York Avenue, NW
Washington DC 20001
(202) 346-4000

Attorney for Applicant